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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,122	11/20/2003	R. Christopher Carney	102863-23	9095

21125 7590 07/01/2008  
NUTTER MCCLENNEN & FISH LLP  
WORLD TRADE CENTER WEST  
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BOSTON, MA 02210-2604

EXAMINER
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ELVE, MARIA ALEXANDRA

ART UNIT	PAPER NUMBER
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3742

NOTIFICATION DATE	DELIVERY MODE
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07/01/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@nutter.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/718,122	<b>Applicant(s)</b> CARNEY ET AL.	
	<b>Examiner</b> M. Alexandra Elve	<b>Art Unit</b> 3742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 & 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimura et al. (JP01-215290) in view of Takahashi (USPN 4,581,939).

Kimura et al. discloses an apparatus and method for the laser cutting of cells. The condenser lens is vibrated in the axial direction of the laser beam. In addition the stage of the workpiece vibrates.

Kimura et al. does not teach the use of a spherical lens.

Takahashi disclose the use of vibration and a laser to find defects ultrasonically. One half of the parallel rays of the light are projected on the surface of the specimen by a half mirror and another half of the parallel rays of light are projected on the surface of the specimen by a spherical lens.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use a spherical lens as taught by Takahashi it is merely a specific type of lens used in laser system and hence is a design choice and variation (design variation and rearrangement of parts is known in the art).

Claims 1 & 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bosch (DE 39-38-779 A1) in view of Hillier (USPN 2,496,051) and Takahashi.

Bosch discloses the laser drilling of small holes in a metal part. The laser microdrills the metal to form boreholes. Drilling material (debris) is ejected due to the vibration of the workpiece. Vibration is transmitted to the ram (12, 13) and subsequently the work holder (3). The oscillation generator is connected (9).

Hillier discloses a specimen stage resting close to a lens whereby external vibrations communicate through the equipment frame to the lens and also to the stage. Thus both vibrate in unison.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have the lens and stage (frame) vibrate in unison, as taught by Hillier in the Bosch apparatus and method because it minimizes machining errors due to drift.

Bosch does not teach the use of a spherical lens.

Takahashi disclose the use of vibration and a laser to find defects ultrasonically. One half of the parallel rays of the light are projected on the surface of the specimen by a half mirror and another half of the parallel rays of light are projected on the surface of the specimen by a spherical lens.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use a spherical lens as taught by Takahashi it is merely a specific type of lens used in laser system and hence is a design choice and variation (design variation and rearrangement of parts is known in the art).

Claims 2-4 & 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kimura et al. and Takahashi, as stated above and further in view of Mosavi et al. (USPN 6,252,195).

Kimura et al. does not teach the type of laser, the formation of a hole, or the formation of a surgical needle.

Mosavi et al. discloses forming holes in a surgical needle using an Nd-YAG laser. High-energy laser pulses form a blind hole in the proximal end of a surgical needle.

It would have been obvious to one of ordinary skill in the art at the time of the invention to make surgical needles, as taught by Mosavi et al., in the Kimura et al. system because the vibrational system ensures a high quality bore hole.

The rearrangement of parts was held to have been obvious. In re Japikse 86 USPQ 70.

Claims 2-4 & 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bosch, Hillier and Takahashi, as stated above and further in view of Mosavi et al.

Bosch does not teach the type of laser or the formation of a surgical needle.

Mosavi et al. discloses forming holes in a surgical needle using an Nd-YAG laser. High-energy laser pulses form a blind hole in the proximal end of a surgical needle.

It would have been obvious to one of ordinary skill in the art at the time of the invention to make surgical needles, as taught by Mosavi et al., in the Bosch system because the vibrational system ensures a high quality bore hole.

The rearrangement of parts was held to have been obvious. In re Japikse 86 USPQ 70.

### ***Response to Arguments***

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Alexandra Elve whose telephone number is 571-272-1173. The examiner can normally be reached on 7:30-4:00 Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tu B. Hoang can be reached on 571-272-4780. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

June 23, 2008.

/M. Alexandra Elve/  
Primary Examiner, Art Unit 3742